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10/500,474

08/09/2004

Thomas Margaria

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23338 7590 06/25/2008
DENNISON, SCHULTZ & MACDONALD
1727 KING STREET
SUITE 105
ALEXANDRIA, VA 22314

EXAMINER

MAI, NGOCLAN THI

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

06/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/500,474 | Applicant(s) MARGARIA, THOMAS | |
| | Examiner NGOCLAN T. MAI | Art Unit 1793 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-20 and 28 is/are rejected.
- 7) ☐ Claim(s) 21-27 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 15-29 are currently under examination. No amendment was filed in the response filed 3/19/08.

Status of Previous Rejection

2. The previous rejections to claims 15, 17-19 under 35 U.S.C. 102(b) as being anticipated by Meacock, II et al is withdrawn in light of applicant's argument filed 3/19/08, see page 1 and
2. However, the previous rejection of claims 15-19 and 28 under 35 U.S.C. 103(a) as being unpatentable over Wehmeier et al. in the Office action of dated 1/2/08 is maintained for the reasons as follow.

Applicant essentially argues that Wehmeier does not suggest a combination of the ferrosilicon and pure magnesium and the calcium, magnesium or aluminum are disclosed as being in alloy form.

The examiner disagrees in that it would have obvious to one skilled in the art combine ferrosilicon with any materials listed as equivalent to ferrosilicon because it is well settled that it is a matter of obviousness for one skilled in the art to combine two or more materials when each is taught by the prior art to be useful for the same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Therefore one skilled in the art would have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skilled in the art at the time of the invention. Concerning the argument that calcium, magnesium or aluminum are disclosed as being in alloy form, the examiner disagrees because Applicant's argument of

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instant remarks is noted. But applicants fail to substantiate their position by factual evidence or point out wherein the prior reference teaches that the calcium, magnesium or aluminum are in alloy form.

3. Upon further consideration and search, claims are further rejected as follow.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 15, 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Henning et al. (U.S. Patent No. 4,313,758).

Concerning claims 15, 17-19, Henning et al discloses a powder product comprising finely sized unalloyed magnesium metal blended with finely sized ferrosilicon alloy. See abstract and column 1, lines 55-58. Unalloyed magnesium and ferrosilicon read on the claimed at least one strongly reducing metal and at least one of inoculating alloy, respectively. The examiner notes that the Henning et al does not teach the powder product is for the protection of centrifugal casting molds used for the manufacture of cast iron pipe. However the "for the protection..." is a statement of intended use which carry no weight in the claims. The "for the protection ... used for the manufacture of cast iron pipe" recitation of claim 1 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness

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but, instead, the process steps or structure limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Concerning claim 20, Henning et al discloses unalloyed magnesium present in the blend can range from 4 to 25% by weight of the unalloyed magnesium and ferrosilicon alloy. See column 2, lines 55-58.

6. Claims 15, 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shea et al. (U.S. Patent No. 4,224,069).

Concerning claims 15, 17-19, Shea et al discloses a powder mixture comprising unalloyed magnesium metal and ferrosilicon alloy. See column 2, lines 20-25. Unalloyed magnesium and ferrosilicon read on the claimed at least one strongly reducing metal and at least one of inoculating alloy, respectively. The examiner notes that the Henning et al does not teach the powder product is for the protection of centrifugal casting molds used for the manufacture of cast iron pipe. However the "for the protection..." is a statement of intended use which carry no weight in the claims. The "for the protection ... used for the manufacture of cast iron pipe" recitation of claim 1 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structure limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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7. Claims 21, 22-27 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NGOCLAN T. MAI whose telephone number is (571)272-1246. The examiner can normally be reached on 8:30-5:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art Unit
1793

n.m.

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